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UNITED STATES PATENT AND TRADEMARK OFFICE
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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES
_____

Ex parte: DONALD K. NEWELL, DAVID W. DOERNER
and RAJIV CHOUDHARY
_____

Application No. 09/474,783
Technology Center 2400
_____

Mailed: April 8, 2009
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Before ERIC W. HAWTHORNE, *Supervisory Paralegal Specialist*
HAWTHORNE, *Supervisory Paralegal Specialist.*

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent
Appeals and Interferences on February 10, 2009. A review of the
application revealed that it is not ready for docketing as an appeal.
Accordingly, the application is herewith being returned to the Examiner to
address the following matter(s) requiring attention prior to docketing.

APPEAL BRIEF, CLAIMS APPENDIX

A review of the Appeal Brief filed May 5, 2008 reveals that claim(s) 1, 7, 19, and 22 and in the Claims Appendix of the Appeal Brief are not consistent as amended in the last entered amendment filed on April 20, 2007. The copy of the claims should be in proper format and should not include any markings such as brackets or underlining except for claims in a reissue application in accordance with 37 C.F.R. 41.37(c)(1)(viii). Furthermore, the Claims Appendix cannot assume entry of After Final Submissions for which an Advisory Action (or other Office communication) has not advised of entry. *See also Manual of Patent Examining Procedure* (MPEP) § 1205.02 (8th ed. Rev. 6, Sept 2007) for details.

Specifically, Claim 1, as provided in the Brief's Claims Appendix, reads:

> 1. A system comprising a receiver in communication with a source of broadcast content and coupled to a playback device and a storage device, the receiver comprising a data interface having an Internet Protocol (IP) data module to process a broadcast stream comprising IP encapsulated data, the receiver to control the use of received broadcast content through the playback device and the storage device in accordance with a descriptor embedded in the received broadcast content, the descriptor to indicate whether the storage device may store the received broadcast content prior to viewing and without reproducing the received broadcast content, and once stored, a number of times the playback device may reproduce the received broadcast content.

However, in the last entered Amendment dated April 20, 2007, Claim 1 reads:

> 1. (Currently Amended) A system comprising a receiver in communication with a source of broadcast content and

coupled to a playback device and a storage device, the receiver comprising a data interface having an Internet Protocol (IP) data module to process a <u>pay-per-use IP television</u> broadcast stream comprising IP encapsulated data, the receiver to control the use of received broadcast content through the playback device and the storage device in accordance with a descriptor embedded in the received broadcast content, the descriptor to indicate whether the storage device may store the received broadcast content prior to viewing and without reproducing the received broadcast content, and once stored, a number of times the playback device may reproduce the received broadcast content.

Additionally, Claim 7, as provided in the Brief's Claims Appendix, reads:

> 7. A method comprising:
> receiving broadcast content comprising Internet Protocol (IP) encapsulated data;
> processing the IP encapsulated data by extracting a descriptor embedded in the received broadcast content, the descriptor to indicate whether the received broadcast content may be stored prior to viewing and without reproducing the received broadcast content, and once stored, a length of time the received broadcast content may be reproduced;
> controlling use of the received broadcast content in accordance with the extracted descriptor;
> wherein the extracted descriptor indicates a number of times that the received broadcast content may be reproduced.

However, in the last entered Amendment dated April 20, 2007, Claim 7 reads:

> 7. (Currently Amended) A method comprising:

receiving ~~pay-per-use Internet Protocol (IP)~~
~~television~~ broadcast content comprising ~~Internet Protocol~~
~~(IP)~~ IP encapsulated data;

processing the IP encapsulated data by extracting a
descriptor embedded in the received broadcast content,
the descriptor to indicate whether the received broadcast
content may be stored prior to viewing and without
reproducing the received broadcast content, and once
stored, a length of time the received broadcast content
may be reproduced;

controlling use of the received broadcast content in
accordance with the extracted descriptor;

wherein the extracted descriptor indicates a
number of times that the received broadcast content may
be reproduced.

Additionally, Claim 19, as provided in the Brief's Claims Appendix,

reads:

19. A machine-readable medium having stored
thereon a set of executable instructions to perform a
method comprising:

receiving broadcast content comprising Internet
Protocol (IP) encapsulated data;

processing the IP encapsulated data by extracting a
descriptor embedded in the received broadcast content,
the descriptor to indicate whether the received broadcast
content may be stored prior to viewing and without
reproducing the received broadcast content, and once
stored, a length of time the received broadcast content
may be reproduced; and

controlling use of the received broadcast content in
accordance with the extracted descriptor;

wherein the extracted descriptor indicates a
number of times that the received broadcast content may
be reproduced.

However, in the last entered Amendment dated April 20, 2007, Claim

19 reads:

19. (Currently Amended) A ~~machine~~ <u>computer-</u>readable medium having stored thereon a set of executable instructions ~~to~~ <u>that when executed by a computer system</u> perform a method comprising:

receiving <u>pay-per-use Internet Protocol (IP) television</u> broadcast content comprising ~~Internet Protocol (IP)~~ <u>IP</u> encapsulated data;

processing the IP encapsulated data by extracting a descriptor embedded in the received broadcast content, the descriptor to indicate whether the received broadcast content may be stored prior to viewing and without reproducing the received broadcast content, and once stored, a length of time the received broadcast content may be reproduced; and

controlling use of the received broadcast content in accordance with the extracted descriptor;

wherein the extracted descriptor indicates a number of times that the received broadcast content may be reproduced.

Additionally, Claim 22, as provided in the Brief's Claims Appendix, reads:

22. A system comprising a receiver in communication with a source of broadcast content and coupled to a playback device and a storage device, the receiver comprising a data interface having an Internet Protocol (IP) data module to process a broadcast stream comprising IP encapsulated data, the receiver to control the use of received broadcast content through the playback device and the storage device in accordance with a descriptor embedded in the received broadcast content, the descriptor to indicate whether the storage device may store the received broadcast content prior to viewing, and once stored, a number of times the playback device may reproduce the received broadcast content.

However, in the last entered Amendment dated April 20, 2007, Claim 22 reads:

22. (Currently Amended) A system comprising a receiver in communication with a source of broadcast content and coupled to a playback device and a storage device, the receiver comprising a data interface having an Internet Protocol (IP) data module to process a <u>pay-per-use IP television</u> broadcast stream comprising IP encapsulated data, the receiver to control the use of received broadcast content through the playback device and the storage device in accordance with a descriptor embedded in the received broadcast content, the descriptor to indicate whether the storage device may store the received broadcast content prior to viewing, and once stored, a number of times the playback device may reproduce the received broadcast content.

Appropriate correction of all claims provided in the Claims Appendix in proper format is required.

<div align="center">

CONCLUSION

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Accordingly, it is

ORDERED that the application is returned to the Examiner to:

1) notify Appellant to file a paper properly correcting the Claims Appendix of the Brief filed May 5, 2008; and

2) for such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

EWH/nhl

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